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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,493	10/31/2001	Frank R. Carruba	10012809-1	3226

7590 04/15/2004

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER


MAYEKAR, KISHOR

ART UNIT	PAPER NUMBER
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1753

DATE MAILED: 04/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center">Office Action Summary</p>	<p>Application No.</p> <p align="center">10/001,493</p>	<p>Applicant(s)</p> <p align="center">CARRUBA, FRANK R.</p>	
	<p>Examiner</p> <p align="center">Kishor Mayekar</p>	<p>Art Unit</p> <p align="center">1753</p>	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 13-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| <p>1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date <u>10/01</u>.</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)
 Paper No(s)/Mail Date. ____.</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6) <input type="checkbox"/> Other: ____.</p> |
|---|---|

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-12, drawn to a mechanism, classified in class 204, subclass 600+.
 - II. Claims 13-17, drawn to a printer cartridge, classified in class 347, subclass 20+.
 - III. Claims 18-20, drawn to a method, classified in class 204, subclass 450+

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Groups I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different effects: one is mechanism and the other is a print cartridge.

3. Inventions of Groups III and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as a process for continuously pumping a fluid.

4. Inventions of Groups III and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different effects: one is a print cartridge and the other is a method of ejecting a droplet of a fluid.

5. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II or III, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Attorney M. Dryja on April 10, 2004 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-12. Affirmation of this election must be made by applicant in replying to this Office action. Claims 13-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the displacement of the membrane and of the ink (or the energy transfer from the electrolytic solution to the membrane, and from the membrane to the ink) which causes a droplet of ink to break free from the ink, such that the droplet of ink is ejected from the print head mechanism, does not reasonably provide enablement for the membrane discharging

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the droplet. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1 and 6-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over HOPKINS, JR. (5,671,905). The reference's invention is directed to an electrochemical actuator using electrochemical generation of gases for pneumatic actuation. The reference discloses that the electrochemical actuator comprises a sealed quantity of electrolytic solution; a measured quantity of fluid; and a membrane exposed to the electrolytic solution on one side and to the fluid on

another side (see Fig. 1 and col. 5, line 57 through col. 8, line 23). The difference between the reference and the above claims is the function of the device. However, it has been held that "apparatus claims what a device is, not what the device does, *Hewlett-Packard co. v. Bausch & Lomb Inc.* 15 USPQ 1525.

As to the subject matter of claim 8, the forming of the plate in a claimed device cannot be give any patentable weight.

11. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over HOPKINS '905 as applied to claims 1 and 6-12 above, and further in view of JOHNSON et al. (5,325,880). The difference between the reference as applied above and the instant claims are the use of a die to encase the electrolytic solution. JOHNSON shows the use of a silicon die in an actuator (Fig. 2). The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the reference's teachings as suggested by JONHSON because the actuator fabricated in silicon is the method of choice for microdevices and further because the motivation to make a specific structure is always related to the properties or uses one skilled in the

art would expect the structure to have, *In re Newell* 13 USPQ 2d 1248, *Fromson v. Advance Offset Plate* 225 USPQ 26; *In re Gyurik* 201 USPQ 552.

12. Claims 1 and 6-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over HOPKINS '905 in view of LERAT et al. (6,309,043). The difference between reference applied above and the above claims is the function of the device. LERAT shows in a device using the action of a gas for controlling the movement of a fluid the use of such device in ink jet printing technology (see Field of the Invention). The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the reference's teachings as suggested by LERAT because the selection of any of known equivalent functions of the device of converting pressure to motion or displacement for use in ink jet printing would have been within the level of ordinary skill in the art.

13. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over HOPKINS '905 as modified by LERAT '043 as applied to claims 1 and 6-12 above, and further in view of JOHNSON '880. The difference between the references

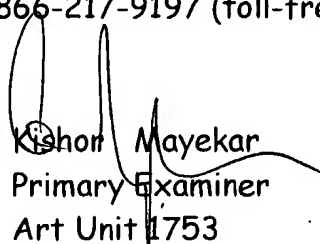
as applied above and the instant claims are the use of a die to encase the electrolytic solution. JOHNSON shows the use of a silicon die in an actuator (Fig.

2). The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the reference's teachings as suggested by JONHSON because the actuator fabricated in silicon is the method of choice for microdevices and further because the motivation to make a specific structure is always related to the properties or uses one skilled in the art would expect the structure to have, *In re Newell* 13 USPQ 2d 1248, *Fromson v. Advance Offset Plate* 225 USPQ 26; *In re Gyurik* 201 USPQ 552.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kishor Mayekar whose telephone number is (571) 272-1339. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kishor Mayekar
Primary Examiner
Art Unit 1753